

**Proposed Topics for Discussion Purposes Only For Interview Scheduled for April 20, 2004**

Application No. 10/070,782

April 16, 2004

Examiner Preeti Kumar

Art Unit 1751

Phone No. 571.272.1320

Fax No. 571.273.1320

**REMARKS**

The Applicants respectfully submit that Akasawa does not teach or suggest the Applicants' limitation as recited in Amended Claim 1. The Examiner indicates in the paragraph bridging pages 3 and 4 of the Office Action that the abstract of Akasawa states "the ratio of said second polyurethane (b) to said first polyurethane (a) being in a range of 0.5 to 50% by weight." The Applicants respectfully submit, however, that as seen in the Table on page 13 of the Applicants' response submitted October 31, 2003, it was indicated that the amount of polycarbonate diol in polyurethane (a) is less than 40%. The Applicants respectfully submit that 40% is the amount of polycarbonate diol based on the total weight of diol (A) and diol (B) in polyurethane (a). In addition, polyurethane (a) further comprises "low molecular weight diol (E)".

The Applicants submit herewith a summation of Table 1 of Akasawa which describes the weight percentage of polycarbonate diol in Examples 1 to 9. The Applicants respectfully submit that the Table shows that the total weight of the polymer diol is the combination of the weight of diol (A) plus the weight of diol (B) of Table 1 in Akasawa. Further, Applicants submit that only the PHC of Table 1 is a polycarbonate diol.

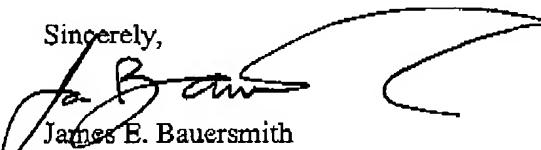
	Wt. Of diol in Table 1				Total wt. of diol: ①	Wt. of PHC: ②	①/②*100
	(A)	(B)					
Ex.1	11.9	620	580	600	1811.9	620	34.2
Comp. Ex. 1		690	644	666	2000	690	34.2
Ex. 2	11.9	350	550		911.9	350	38.4
Comp. Ex. 2	11.9	350	550		911.9	350	38.4
Ex. 3	26.1	600	1100		1726.1	600	34.8
Comp. Ex. 4	26.1	600	1100		1726.1	600	34.8

Ex. 4	200	300	600		1100	300	27.3
Comp. Ex. 6		333	667		1000	333	33.3
Comp. Ex. 8	200	300	600		1100	300	27.3
Ex. 5	100	600	1300		2000	600	30.0
Comp. Ex. 9	100	600	1300		2000	600	30.0
Ex. 6	200	800	1000		2000	800	40.0

The Applicants respectfully submit that the abstract of Akasawa states that "a first polyurethane (a) obtained by reacting: an intermediate product diol (D) obtaining by reacting ... diol (A), a diol (B) ... selected from the group consisting of ... polycarbonates ... and an organic diisocyanate (C1) ... a low molecular weight diol (E), and diphenylmethane - 4, 4' - diisocyanate (C2). The Applicants respectfully submit that the polyurethane disclosed in Akasawa contains polycarbonate diol in an amount well below 40% by weight of total diol components.

The Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The Applicants respectfully submit that in order to establish *prima facie* obviousness, all of the claimed limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). In particular, the case of *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970), states that "all words in a claim must be considered in judging the patentability of that claim against the prior art."

In view of the foregoing, the Applicants respectfully submit the Application is now in condition for allowance, which is respectfully requested.

Sincerely,  
  
 James E. Bauersmith  
 Reg. No. 50,533

JBB:ks